

***Remarks***

Claims 4-6, 9-11, 24, 26, and 35 to 42 are now pending in the application, with claims 4, 6 and 24 being the independent claims. Claims 4, 6, 9 and 24 have been amended, and claims 37 to 42 are newly presented. The instant amendments are believed to introduce no new matter. Applicants wish to confirm that the Response of September 27, 2005 also introduced new claim 36 (the Examiner did not identify same on the cover sheet of the Office Action), although it was identified in the Office Action *per se*.

Support for the amendments to the claims can be found throughout the specification as well as in the claims as originally filed. For example, support for the association with a non-malignant prostatic state (as recited in claims 4, 6 and 24 can be found, for example from page 5, line 21 to page 6, line 2). Support for a nucleic acid molecule consisting of 11 to 50, 15 to 50, 18 to 50 and 20 to 50 nucleotides in claims 6 and 37 to 39, can be found, for example, at page 34, from line 1 to line 4. Support for new claims 40-42 can be found in old claim 9, except for their dependencies to a nucleic acid molecule consisting of 11 to 50, 15 to 50, 18 to 50 and 20 to 50 nucleotides as described above.

Applicants thank the Examiner for the withdrawal of the rejection of claims 10 and 11 under 35 U.S.C. 112, first paragraph, for failing to comply with the written description requirement.

***Rejections Under 35 U.S.C. § 112, first paragraph***

The rejection of claims 4, 5, 10, 11, 24, 35 and 36 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement is respectfully traversed.

In view of Examiner's comment regarding the expression "differentially expressed", Applicants have amended claims 4 and 24 to replace the latter terminology with the terminology "associated with a non-malignant prostatic state, as fully supported by the disclosure (as indicated by the Examiner). Further, for consistency, a similar amendment has been introduced in claim 6, although no objection was raised thereto.

The above-mentioned amendment is should not be taken as an admission by the Applicants that the recitation of "nucleic acid molecule is differentially expressed in a non-malignant prostate" is not fully supported by the specification. Applicants respectfully disagree with this contention of the Examiner. The amendment was made solely to expedite prosecution.

Accordingly, reconsideration and withdrawal of the rejection of 4, 5, 10, 11, 24, 35 and 36 under 35 U.S.C. § 112, first paragraph, is respectfully requested.

***Rejections Under 35 U.S.C. § 102***

The new rejection of claims 6 and 9 under 35 U.S.C. § 102(e) as allegedly being anticipated by US Pat. 6,528,260 (Blumenfeld et al., with priority to 03/25/1999 and 04/30/1999) is respectfully traversed.

Amended claims 6 9 and 26 are now drawn to a nucleic acid molecule consisting of 11 to 50 consecutive nucleotides from nucleotides 27 to 254 of SEQ ID NO:1 and a kit comprising said nucleic acid molecule. Blumenfeld et al., teaches a number of sequences, one of which (sequence 711) is a 37 nucleotide sequence having a 10 consecutive nucleotide match with nucleotides 27 to 254 of SEQ ID NO:1. Moreover, Blumenfeld does not teach sequences being linked to prostatic state.

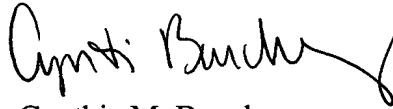
In view of the above, reconsideration and withdrawal of the rejection of claims 6, 9 and 26 under 35 U.S.C. § 102(e) are respectfully requested.

***Conclusion***

Prompt and favorable consideration of this Amendment is respectfully requested. Applicants believe the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Cynthia M. Bouchez  
Attorney for Applicants  
Registration No. 47,438

Date: May 5, 2006  
1100 New York Avenue, N.W.  
Washington, D.C. 20005-3934  
(202) 371-2600